

REMARKS

Claims 1, 3-9, 16-18 and 20-41 are pending in this application. Claims 1, 16-18 and 25-26 are independent. In light of the remarks made herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejection.

By this amendment, Applicant has amended the claims to more appropriately recite the present invention. It is respectfully submitted that these amendments are being made without conceding the propriety of the Examiner's rejections, but merely to timely advance prosecution of the present application.

In the outstanding Official Action, the Examiner rejected claims 17-18 and 20 under 35 U.S.C. §102(b) as being anticipated by *Lazzouni et al.* (USP 5,652,412); rejected claims 1, 3-9, 21-27 and 34-40 under 35 U.S.C. § 103(a) as being unpatentable over *Lazzouni et al.* (USP 5,652,412) in view of *Beernink et al.* (USP 5,710,831); rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over *Lazzouni et al.* in view of *Yoshida* (USP 5,128,526); and rejected claims 28 and 33 under 35 U.S.C. § 103(a) as being unpatentable over *Lazzouni et al.* in view of *Burges et al.* (USP 5,727,082). Applicant respectfully traverses these rejections.

Applicant wishes to thank the Examiner for indicating that claim 41 includes allowable subject matter.

I. Claim Rejections – 35 U.S.C. § 102 - *Lazzouni et al.*

In support of the Examiner's rejection of claim 18, the Examiner asserts that *Lazzouni et al.* discloses:

Registering (optical position) strokes when the electronic pen is moved (optical position by raced strokes on the surface, fig. 1); determining if the strokes (s,i,a,) comprise a command (sia); and carrying out an operation upon determination of the command, wherein the registering strokes includes recording the command electronically by detecting a position code arranged on a writing surface, upon which the command is written (see encoded position information, see col. 2, lines 44-52, and see abstract, see col. 5, lines 7-12).

A. The Examiner has failed to consider all of the claim elements

As can be seen from the above rejection, the Examiner has clearly failed to consider all of the claim elements. Claim 18 clearly recites, *inter alia*, carrying out an operation upon determination of the command. However, the Examiner has failed to identify any teachings in the cited reference that are directed to this claim element. As the Examiner has failed to consider all of the claim elements, it is respectfully submitted that the Examiner has failed to establish *prima facie* anticipation. It is respectfully requested that the outstanding rejection be withdrawn.

B. *Lazzouni et al.* fails to teach or suggest “determining if the strokes comprise a command” as recited in claim 18

The disclosure of *Lazzouni et al.* is directed to a pen and paper information recording system. At col. 4, lines 51-65, *Lazzouni et al.* discloses as follows:

A pictorial diagram of the information recording apparatus of the present information is shown in FIG. 1. A pen 10 is used for making visible markings 12 on an encoded paper 14. The pen is connected by a cable 16, which may include optical fibers and/or electrical conductors, to a recording unit 20. The visible markings 12, which can be handwriting, drawings or any other markings on a writing surface of encoded paper 14, are traced by a tip 18 of pen 10. Simultaneously, the absolute position of the tip 18 of pen 10 on the surface of paper 14 is determined by optically reading a pattern of prerecorded pixels associated with the surface of paper 14. The position information is transmitted through the cable 16 to recording unit 20, where it is stored for later use. The recording unit 20 thus contains an electronic representation of the markings 12.

As can be seen from the above disclosure, *Lazzouni et al.* merely teaches a pen connected to a recording unit. The pen may be used to mark on a writing surface of encoded paper wherein the position information is transmitted to the recording unit.

In contrast, the present invention as set forth in claim 1 recites, *inter alia*, a method for controlling an electronic pen, the electronic pen being adapted to carry out at least one operation, comprising determining if the strokes comprise a command. The Examiner asserts that this element is taught by the “sia” written on the writing surface as shown in Fig. 1. However, there

is no disclosure in *Lazzouni et al.* that is directed to determining whether “sia” comprises a command. Applicant does not believe that “sia” is inherently a command.

Further, it is clear from the disclosure that the process that occurs in the pen happens regardless of what is written on the writing surface. As such, Applicant maintains that *Lazzouni et al.* fails to teach or suggest this claim element.

As *Lazzouni et al.* fails to teach or suggest all of the claim elements, it is respectfully submitted that the Examiner has failed to establish *prima facie* anticipation. It is respectfully requested that the outstanding rejection be withdrawn.

C. *Lazzouni et al.* fails to teach or suggest “carrying out an operation upon determination of the command” as recited in claim 18

As noted above, *Lazzouni et al.* fails to teach or suggest determining if the strokes comprise a command. As such, there can be no teaching in *Lazzouni et al.* that anticipates “carrying out an operation upon determination of the command” as recited claim 18. As such, Applicant maintains that *Lazzouni et al.* fails to teach or suggest this claim element.

As *Lazzouni et al.* fails to teach or suggest all of the claim elements, it is respectfully submitted that the Examiner has failed to establish *prima facie* anticipation. In addition, none of the other cited references cure the deficiencies of the teachings of *Lazzouni et al.* For all of the reasons set forth above, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claim 20 is allowable for the reasons set forth above with regard to claim 18 at least based upon its dependency on claim 18. It is further respectfully submitted that claim 17 includes at least one element similar to those discussed above with regard to claim 18 and thus claim 17 is allowable over the art as cited by the Examiner.

II. Claim Rejections – 35 U.S.C. § 103 - *Lazzouni et al./Beernink et al.*

In support of the Examiner's rejection of claim 1, the Examiner asserts the following:

Regarding claims 1, 25, Lazzouni et al. discloses in fig. 1, an electronic pen (10) which is adapted to carry out at least one operation, the electronic pen comprising: a registration device (optical position, see abstract) for registering strokes when the electronic pen is moved (see fig.1, see pen tip 10 moved and tracked the "sia" on the paper 14, Lazzouni et al. discloses the strokes "s,i,a" comprises a command "sia", fig. 1; and processor means (see microprocessor 132 and memory 134 for processing and recording the position information, see col. 4, lines 30-35) for carrying out an operation upon determination of a command (sia), wherein the registration device (optical position) is adapted to record the command electronically by detecting a position code (see encoded position information, see col. 2, lines 44-52) arranged on a writing surface, upon which the command is written (see abstract, see col. 5, lines 7-12).

However, Lazzouni et al. does not disclose the electronic pen comprising an interpretation means.

Beernink et al. discloses a handwriting on the based computer comprising a plurality of character interpretations of the character handwritten input show in fig. 2b. (see col. 7, lines 50-63).

It would have been obvious ... to implement the character interpretations as taught by Beernik into the electronic pen of Lazzouni et al. for producing the claimed invention because this would provide a list of character ranging from the most probably to the least probable interpretation of the input (see col. 7, lines 58-60).

Applicant respectfully disagrees that all of the elements are taught by the combination of the teachings of the cited references. Applicant further respectfully submits that the Examiner's statement of motivation fails to address why one skilled in the art would be motivated to modify *Lazzouni et al.* with the purported interpretation means of *Beernink et al.*

A. Lazzouni et al. fails to teach or suggest “carrying out an operation upon determination of said command” as recited in claim 1.

The Examiner relies on the teachings of *Lazzouni et al.* to teach “carrying out an operation upon determination of said command.” However, the Examiner admits that *Lazzouni et al.* fails to teach or suggest interpretation means for determining if the strokes comprise a command. As the Examiner has admitted the deficiency of the teachings of *Lazzouni et al.* of the interpretation means for determining if the strokes comprise a command, there can be no teaching in *Lazzouni et al.* that is directed to carrying out an operation upon determination of said command. In other words, if *Lazzouni et al.* fails to teach or suggest interpretation means for determining if the strokes comprise a command, there can be no reasonable interpretation of the disclosure of *Lazzouni et al.* that is directed to carrying out an operation **upon determination of said command**.

It is respectfully submitted that *Bernink et al.* fails to cure the deficiencies of the teachings of *Lazzouni et al.* as *Bernink et al.* fails to teach or suggest carrying out an operation upon determination of said command. As neither of the references, either alone or in combination, assuming the references are combinable, which Applicant does not admit, teach or suggest this claim element, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness. It is respectfully requested that the outstanding rejection be withdrawn.

B. The purported combination of the cited references fails to teach the claimed invention.

The disclosure of *Bernink et al.* is directed to a pen based system that includes a display that is sensitive to the position of a stylus. Any purported interpretation means of *Bernink et al.* is located at the computer, not at the stylus. There is no teaching or suggestion in *Bernink et al.* that is directed to an electronic pen including interpretation means. As such, even if the modifications purported by the Examiner were made to *Lazzouni et al.*, the combination would not result in teaching an electronic pen, which is adapted to carry out at least one operation, the electronic pen comprising interpretation means for determining if the strokes comprise a command.

In addition, in support of the Examiner's rejection, the Examiner admits that *Lazzouni et al.* "does not disclose the electronic pen comprises an interpretation means." However, the Examiner fails to consider the whole claim element, namely "interpretation means **for determining if the strokes comprise a command.**" The Examiner seeks to cure the deficiencies of the teachings of *Lazzouni et al.* by the teachings of *Beernink et al.*, namely "a plurality of character interpretations of the character handwritten input show in fig. 2b. (see col. 7, lines 50-63)." However, neither "the plurality of character interpretations of the character handwritten input" nor the teachings at col. 7, lines 50-63 teach or suggest determining if the strokes comprise a command. As such, even if the teachings were combined, the resultant device would still be deficient, as the resultant device would not determine if the strokes comprise a command, as required by the claim.

At least for these reasons, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements.

C. There is no motivation to modify the pen of *Lazzouni et al.* with the purported interpretation means of *Bernink et al.*

Applicant maintains that there is insufficient motivation to satisfy the Examiner's burden in establishing *prima facie* obviousness. The Examiner asserts that one skilled in the art would have been motivated to combine the teachings of the cited references to implement the character interpretations as taught by *Beernink et al.* into the electronic pen of *Lazzouni et al.* for producing the claimed invention because this would provide a list of characters ranging from the most probably to the least probable interpretation of the input. However, *Lazzouni et al.* is not concerned with character recognition. As such, one skilled in the art would not seek to modify *Lazzouni et al.* to provide a list of characters ranging from the most probably to the least probable interpretation of the input, because *Lazzouni et al.* is not concerned with determining any list of characters.

In addition, the Examiner's statement of motivation fails to address why one skilled in the art would be motivated to include the purported interpretation means **in the pen** of *Lazzouni et al.*, as opposed to **the computer** as taught by *Bernink et al.*

For all of these reasons, it is respectfully submitted that there is no motivation to combine the references as purported by the Examiner. As such, the Examiner has failed to establish *prima facie* obviousness.

D. The Examiner's purported combination of the teachings of the references amounts to impermissible hindsight.

By asserting it would have been obvious to modify *Lazzouni et al.* to include the features of *Bernink et al.* with no suggestion of motivation in the applied references or elsewhere to do so, the rejection appears to rely on impermissible hindsight reasoning.

For all of the reasons set forth above, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness. None of the other cited references cure the deficiencies of the teachings of *Lazzouni et al.* It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 3-9, 27-31 and 41 are allowable for the reasons set forth above with regard to claim 1, at least based upon their dependency on claim 1. It is further respectfully submitted that claim 16 and 25-26 include at least one element similar to those discussed above with regard to claim 1 and thus these claims, together with the claims dependent thereon are patentable over the references as cited by the Examiner.

Conclusion

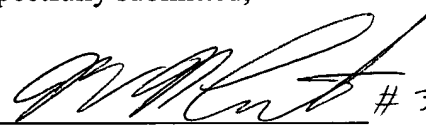
In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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